

**AMENDMENT UNDER 37 C.F.R. § 1.111**  
**U.S. Application No. 10/807,442**

**REMARKS**

The present invention relates to an inkjet ink set comprising at least two inks, wherein one ink contains a betaine compound and at least one other ink contains a nonionic surfactant, and to an inkjet recording method using such an inkjet ink set.

In the Office Action of February 18, 2005, claims 14-16 were objected to, with the Examiner suggesting amending these method claims to delete phraseology using the term “using” and amending to a phrase with the term “comprising”. Obviousness-type double patenting rejections were made with respect to co-pending U.S. Application Nos. 10/611,990, 10/805,251, 10/600,831, 10/806,452, 10/660,653, and 10/806,424.

Turning to the prior art, claims 1-12 and 14-16 were rejected under 35 U.S.C. § 102(a) as being anticipated by EP 1378550 (EP ‘550). Claims 1-12 and 14-16 were also rejected under § 102(a) based on EP 1375608 (EP ‘608), and claims 1-16 were rejected under § 102(a) based on EP 1473336 (EP ‘336), with the Examiner noting with respect to each of the foregoing rejections that Applicant could not rely on the foreign priority papers at the time of the rejection because the translation of the priority papers have not been made of record in the case.

Similarly, claims 1-12 and 14-16 were rejected under 35 U.S.C. § 102(e) based on Miyamoto et al (U.S. 2004/0055508), and separately based on Taguchi et al ‘248 (U.S.

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2004/0011248), and claims 1-16 were rejected under § 102(e) based on Taguchi et al ‘595 (U.S. 2004/0080595). Again with respect to the foregoing rejections under 35 U.S.C. § 102(e), the Examiner noted that Applicant could not yet rely upon the foreign priority papers since a translation of the priority papers had not yet been made of record.

Lastly, claims 1-16 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,980,623 (Hiraoka et al), based on the disclosure therein of an ink for inkjet recording comprising water, a water-soluble organic solvent, a dye of a specified formula, betaine, and a nonionic surfactant.

In accordance with the present Amendment, Applicants have herein amended independent claim 1 in order to further specifically define the betaine and the inks of the inkjet set. This amendment is supported by the disclosure in the specification, e.g., at pages 8 et seq, 19 et seq, 52 et seq, 256, 257 et seq, etc. Furthermore, claims 14, 15, and 16 have been amended as suggested by the Examiner, thereby obviating the Examiner’s objection to these claims. Claims 7-13 have also been amended herein to refer to an inkjet ink set in conformity with claim 1, on which these claims depend directly or indirectly.

With respect to the several double patenting rejections, submitted herewith is a Terminal Disclaimer executed by Mr. Kazuyoshi Hoshi, General Manager, Intellectual Property Technology Division of Fuji Photo Film Co., Ltd. Based thereon, it is respectfully submitted

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that the obviousness-type double patenting rejections have been obviated, and should now be withdrawn.

Also, with respect to the rejections under 35 U.S.C. § 102 based on EP '550, EP '608, EP '336, Miyamoto et al, Taguchi et al '248, and Taguchi et al '595, a Verified Translation of the priority document Japanese Patent Application No. 2003-080221 is submitted herewith. Based thereon, Applicant respectfully submits that Applicant is entitled to the benefit of the filing date of said Japanese Application, which was filed on March 24, 2003, and predates the effective date of the aforesaid references cited in the Office Action. Accordingly, it is respectfully submitted that the foregoing rejections under 35 U.S.C. § 102 have been obviated, and should now be withdrawn.

Lastly, with respect to the Hiraoka et al reference, it is respectfully submitted that the inkjet ink set as is now more specifically defined in accordance with amended independent claim 1 clearly distinguishes over the dyes and betaine compounds described in the Hiraoka et al reference. Accordingly, the rejection based on Hiraoka et al should also now be withdrawn.

In view of the foregoing, it is respectfully submitted that all of claims 1-16 are in appropriate form and distinguish over the cited art, and therefore are now in condition for allowance. Early favorable action is earnestly solicited.

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If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the local Washington, D.C. telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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**23373**  
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Date: August 18, 2005